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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,212	08/31/2001	Thomas M. Kurth	URE02 P-309	2406

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PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER	
COONEY, JOHN M	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,212	KURTH ET AL.	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36,37,40-62 and 76-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36,37,40-62 and 76-82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *18 shts*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 03-08-05 has been entered.

Formal Matters

The submission under 37 C.F.R. 1.312 has **not** been considered or entered in light of the filing of this continued examination application. At this time consideration and entry of this paper would not be appropriate, and the submissions should be submitted in applicants' next reply. The Terminal Disclaimer and amendment to claim 82 have **not** been entered.

Regarding the art statement of 8-31-01, this paper has been found, and the initialed and dated PTO-1449's accompany this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-37, 40-62, and 76-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Croft (5,688,860).

Croft discloses polymer materials comprising the reaction product of isocyanates, isocyanate reactive materials, catalysts, plasticizers, extenders/crosslinkers, and other materials reading on the products as claimed (see column 10 line 60 – column 12 line 40, as well as, the entire document). Distinction between the various reactive materials employed in the making of the isocyanate reactive component are not evident in the claims nor are distinctions between final products evident by limitation in the claim. Distinction of applicants' invention based on the oils being blown is not seen to be evident, as distinction based on such in the final resulting product is not seen to be evident. Additionally, the materials and reactants as well as intermediates employed in the making of the products are seen to read on esterification to the degree defined by the claims such that claims to products containing such recitations are not seen to distinguish over the teachings of Croft.

Claims 76-82 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by WO 00/15684.

WO 00/15684 discloses materials comprising the reaction product of isocyanates, isocyanate reactive materials, and catalysts reading on the products as claimed (see the entire document). Distinction between the various reactive materials employed in the making of the isocyanate reactive component are not evident in the claims nor are distinctions between final products evident by limitation in the claim.

Claims 76-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurth (6,180,686), (6,465,569), (6,624,244), (6,864,296), (6,867,239), (6,881,763) {each taken individually-hereon referred to communally as KURTH}.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

KURTH discloses materials comprising the reaction product of isocyanates, isocyanate reactive materials, and catalysts reading on the products as claimed (see each of the documents in their entirety). Distinction between the various reactive materials employed in the making of the isocyanate reactive component are not evident

in the claims nor are distinctions between final products evident by limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,180,686. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, and vegetable oils combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 6,465,569. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, and vegetable oils combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,624,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, and vegetable oils combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No.

6,864,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, and vegetable oils combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,867,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, and vegetable oils combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,881,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent sets forth materials encompassing products

based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-78 of copending Application No. 09/974,301. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 72-98 of copending Application No. 09/974,302. Although the conflicting claims

are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-52, 60-62,83-85, and 94 of copending Application No. 10/004,733. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/843,943. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 11/042,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in

the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/042,980. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-37, 40-62, and 76-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 11/108,368. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of

the applications set forth materials encompassing products based on isocyanate, catalysts, blowing agents, crosslinkers, vegetable oils, and other elements combined in such a manner that differences in their material make-ups as to the products realized would have been obvious to an ordinary practitioner with the expectation of success in the absence of a showing of new or unexpected results attributable to the formulational make-ups supported by claim limitations

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700